Supreme Court, U.S.
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No. 99-1305

IN THE

Supreme Court of the United States

ELKAY MANUFACTURING COMPANY,

Petitioner,

v.

EBCO MANUFACTURING COMPANY
and EBTECH CORPORATION,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals For The Federal Circuit

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Petitioner's statement of the question is argumentative in violation of Rule 14.1(a) of the Supreme Court Rules. Properly stated, the question presented is whether, after properly stating the governing law of claim construction, the Court of Appeals for the Federal Circuit correctly understood the specific facts set forth in the prosecution histories of the patents-in-suit and correctly applied the law of claim construction to the particular patents in this case when it interpreted the patent claims at issue to be limited to a no-spill adapter having a feed tube with a single flow path for both air and water.

RULE 29.6 STATEMENT

The Respondents, Ebco Manufacturing Company and Ebtech Corporation (now collectively "Oasis Corporation" by acquisition and name change), do not have any parent corporations or nonwholly-owned subsidiaries.

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PRELIMINARY STATEMENT

This case does not include any issue worthy of consideration by the Supreme Court. The decision below does not conflict with the decision of this or any other court, involves no issues of constitutional law, and presents no important questions of federal law. This is merely a case of the Federal Circuit determining on the basis of the unique facts before it that the claim interpretation below contained reversible error and that, as a matter of law, the Respondents' products do not infringe the properly construed claims of the Petitioner's patents.

In light of the Petitioner's statements in the prosecution histories of the patents-in-suit, the Federal Circuit correctly interpreted the asserted claims to be limited to a no-spill adapter having a feed tube with a single flow path for both air and water. More specifically, the Federal Circuit correctly found that in an effort to distinguish the prior art references cited by the Patent Examiner during prosecution of the patents-in-suit, the Petitioner disavowed an interpretation of the asserted claims that would have included a feed tube having separate flow paths for air and water. Because the feed tubes in the Respondents' no-spill adapters have separate flow paths for air and water, the Federal Circuit correctly held that, as a matter of law, the Respondents' adapters do not infringe the asserted claims.

Moreover, the petition is facially deficient because it fails to allege any error worthy of Supreme Court review. The error alleged in the petition is essentially that the Federal Circuit misunderstood the specific facts set forth in the prosecution histories of the patents-in-suit and misapplied the law of claim construction to the particular patents in this case. (*See* Pet. at 17-19.) As specifically stated in Supreme Court Rule 10, however, "[a] petition for a writ of certiorari

is rarely granted when the asserted error consists of erroneous factual findings or the misapplication of a properly stated rule of law" (emphasis added). Even if the Petitioner's allegations were true--which they are not--the Petitioner has failed to provide a compelling reason why the Supreme Court should revisit the decision in this pedestrian case. The Petitioner's mere dissatisfaction with the Federal Circuit's decision does not merit the grant of a writ of certiorari. Accordingly, the petition should be denied.

Furthermore, on December 29, 1999, more than two months before the filing date of the petition, the district court in this case issued an Agreed Order consented to by the Petitioner dismissing the Petitioner's complaint with prejudice. (*See* Resp. App. A at 2a.) As a result, there is no longer an Article III "case or controversy" for the Supreme Court to decide. For this additional reason, the Supreme Court should deny the petition. U.S. Const. art. III, § 2.

COUNTERSTATEMENT OF THE CASE

The petition for a writ of certiorari is particularly meritless because it includes incomplete and misleading characterizations of the prosecution history of the patents-in-suit and the proceedings below. The following counterstatement of the case should serve to rectify any erroneous impressions created by the petition.

I. The Patents and Their Prosecution Histories

Although purporting to "faithfully" represent the statements it made during the prosecution of the patents-in-suit, it is the Petitioner--not the Federal Circuit--that has attempted to improperly "truncate" and "recast" the

prosecution history to recapture subject matter that was clearly relinquished in exchange for the allowance of the patents-in-suit. Indeed, the Petitioner has attempted to mask the statements that do not serve its purpose and to highlight only those statements that it believes support its litigation-induced interpretation of its claims. The petition invites the Supreme Court to "review the language of the [Federal Circuit's] opinion against the true prosecution history of the '531 patent." (Pet. at 19 (emphasis added).) The Respondents respectfully submit that the true prosecution history clearly supports the Federal Circuit's decision.

A. The Patents

The patents-in-suit are U.S. Patent No. 5,222,531 ("the '531 patent") and U.S. Patent No. 5,289,855 ("the '855 patent"). These patents relate to a hygienic liquid delivery system for bottled water coolers and dispensers. The application giving rise to the '855 patent was a continuation of the application leading to the '531 patent. As such, both patents share the same written description and drawings. They differ only in their claims, which recite the claimed invention in varying degrees of detail and include slightly different claim terminology.[1]

The Petitioner alleged at trial that claims 1-5 and 7-10 of the '531 patent and claims 1-3 of the '855 patent were

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[1] The Petitioner has acknowledged that the applications leading to the patents-in-suit are closely related, and that the arguments made during prosecution of the '531 patent are relevant to the interpretation of the claims of the '831 patent. (Pet. at 3 n.1.)

infringed by the Respondents' no-spill adapters.[2] Each of these claims recites a "liquid container support and hygienic delivery system for dispensing drinking water or other potable liquid . . . ." (Pet. App. at B7, B10, B12.) One of the components included in the recited "system" is a "feed tube" or "feed probe" having "a hygienic flow path" or "fluid passage means" for dispensing liquid from the container and for admitting air into the container[3] (Pet. App. at B7, B10, B12.) For example, claim 1 of the '531 patent recites:

> an upstanding feed tube dimensioned to penetrate into said hollow tubular sleeve portion of said coaxial cap and said container neck to provide a hygienic flow path for delivering liquid from said inverted unpressurized container into said reservoir to said predetermined level **and** for admitting air from said reservoir above said liquid level into said container . . . .

(Pet. App. at B8 (emphasis added.).) Similarly, claim 7 of the '531 patent recites:

> [a] hollow feed tube having an internal bore and at least one radial opening . . . defining fluid passage means for dispensing liquid

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[2] Claims 1 and 7 of the '531 patent and claim 1 of the '855 patent are the only independent claims at issue.

[3] The Petitioner has conceded that the "feed probe" element of claim 1 of the '855 patent should be interpreted the same way as the "feed tube" element of claim 1 of the '531 patent. (Pet at 3 n.1.)

> from said container into said reservoir . . . **and** for admitting air from said reservoir above said liquid level into said container . . . .

(Pet. App. at B11 (emphasis added).)

The written descriptions and the drawings of the patents-in-suit describe and show the recited feed tube as having a single flow path for both air and water. (*See* '531 patent, col. 5, lns. 42-51, Figs. 4a-4c; '855 patent, col. 5, lns. 44-50; Figs. 4a-4c.) The specifications contain no disclosure of a feed tube having separate flow paths for air and water.

B. The Prosecution History

During prosecution of the '531 patent, the Examiner rejected pending independent claims 16 and 22 (which issued as claims 1 and 7, respectively), *inter alia*, for obviousness under 35 U.S.C. § 103(a) in view of U.S. Patent No. 2,057,238 to Krug and U.S. Patent No. Re. 32,354 to Savage. (Pet. App. at E11.) The Krug patent relates to a dispensing apparatus that was primarily designed for dispensing beer. In particular, Krug discloses a closed pressurized system that includes a feed tube structure having separate flow paths for air and liquid. This separate flow path feature of the Krug patent is particularly relevant because, as explained above, the patents-in-suit do not disclose a feed tube having separate flow paths for air and water, but rather a feed tube having a single flow path for both air and water. This feature was thus a significant distinction between the claimed invention and the Krug patent.

In response to the Examiner's rejection based on Krug and Savage, the Petitioner amended independent claims 16 and 22 to recite in more detail the claimed feed tube as including "a hygienic flow path" (claim 16) and "fluid passage means" (claim 22) for "delivering" or "dispensing" liquid from the inverted container into the reservoir and "for admitting air" from the reservoir into the container. (Pet. App. at E15-22.) The Petitioner also made the following remarks regarding Krug:

> Krug has no "reservoir open at its upper end" as recited in the preamble of independent claims [1] and [7] and, more importantly therefore, cannot possibly teach or suggest "sealing means carried by said removable mounting means for sealingly closing said open upper end of said reservoir" (claim [1]) or **a "flow path"** (claim [1]) or **"fluid passage means"** (claim [7]) **for "delivering liquid** from said inverted unpressurized container (claim [1]) into said reservoir up to said predetermined maximum liquid level **and for admitting air** from said reservoir above said liquid level into said container" as recited in the body of each of applicants' independent claims [1] and [7].

(Pet. App. at E24 (underlining in original; boldfacing added).)

After submitting the above-mentioned response, the Petitioner conducted an in-person interview with the Examiner to discuss the rejections of claims 16 and 22 based on Krug and Savage. (Pet. App. at E28.) The interview with

the Examiner was documented in an Interview Summary Record prepared by the Examiner and placed in the Patent and Trademark Office's file for the application leading to the '531 patent. *Id.* Although the Interview Summary Record does not describe the particular arguments advanced by the Petitioner at the interview, it indicates that the Examiner and the Petitioner discussed the Krug and Savage patents, and that the arguments made by the Petitioner at the interview convinced the Examiner that claims 16 and 22 were allowable. *Id.*

Shortly after the interview, the Examiner issued a Notice of Allowability, which included the Examiner's Statement of Reasons for Allowance. In his Statement, the Examiner set forth the particular features of the claimed invention that the Examiner considered patentably distinct from the cited prior art:

> [i]n regard to claim 22, **the prior art of record does not teach a . . . feed tube as claimed wherein the feed tube has a passage means which <u>both</u> dispenses liquid from the container into the reservoir <u>and</u> admits air from the reservoir into the container**. In the Krug reference the coil 15 is the reservoir which receives liquid from the container 6 through the feed tube 13. However, 15 is a closed coil that is always submerged by the liquid in the container 6. **<u>Therefore, feed tube 13 does not provide a means for admitting air.</u> Note that Krug provides a <u>separate</u> conduit for exterior air 27/34 in order to relieve the vacuum in the container.**

(Pet. App. at E30 (emphasis added).) Notably, the Examiner's Statement points out in detail how--as argued by the Petitioner in its response--the claimed invention is distinct from Krug based on the fact that Krug fails to disclose a feed tube that has "a passage means which both dispenses liquid from the container into the reservoir and admits air from the reservoir into the container." (Pet. App. at E30 (emphasis added).)

The Examiner's Statement of Reasons for Allowance concluded with an invitation to the Petitioner to submit "[a]ny comments considered necessary" in light of the Examiner's remarks. (Pet. App. at E30.) Notwithstanding the Examiner's clear assertion that he considered the claimed invention as being limited to a system having a feed tube with a single flow path for both air and water, the Petitioner chose to remain silent and failed to express any disagreement with the Examiner's interpretation of the claims or the teachings of the prior art.

In the face of these facts, the Petitioner argues in the petition that it did not distinguish the Krug reference by arguing that the asserted claims include a single flow path for both air and water. The Respondents and the Federal Circuit disagree. When considered in light of the separate flow path feed tube disclosed in Krug, the Petitioner's remarks were clearly intended to distinguish Krug, *inter alia*, on the basis that Krug does not teach or suggest a single flow path or passage means "for delivering liquid from" the container "**and** for admitting air" into the container. Regardless of whether such an argument was actually necessary to overcome the Krug patent, the Petitioner plainly advanced it in an effort to obtain the patents-in-suit.

II. The Proceedings Below

A. The District Court Trial

The district court proceeding consisted of a bench trial that included an initial fact-finding portion wherein both parties presented witnesses on the relevant issues. After the fact-finding portion of the trial was complete, both parties submitted briefs regarding the various legal issues in the case including issues relating to the proper interpretation of the asserted claims. The interpretation of the feed tube element ultimately endorsed by the Federal Circuit was advanced by the Respondents in a brief, which was considered by the district court in its opinion. (Pet. App. at B26-27.) The district court, however, held that the asserted claims were not limited to a feed tube having a single flow path for both air and water, and found that the Respondents' adapters infringed the patents-in-suit.

B. The Federal Circuit's Decision

The Respondents appealed the district court's judgment to the Federal Circuit arguing, *inter alia*, that the district court improperly construed the claims to include a feed tube having separate flow paths for air and water. (Pet. App. at A6.) In accordance with the law of claim construction, the Federal Circuit examined the "intrinsic" evidence of the patents-in-suit to ascertain the meaning of the asserted claims. (Pet. App. at A6-7); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 991 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996); *Spectrum Int'l, Inc. v. Sterilite Corp.*, 164 F.3d 1372, 1378 (Fed. Cir. 1998); *CVI/Beta Ventures, Inc. v. Tura LP*, 112 F.3d 1146, 1152 (Fed. Cir. 1997). It initially examined the words of the

asserted claims and the specification of the patents, but determined that this evidence was inconclusive as to whether the claims are limited to a feed tube having a single flow path for both air and water. (Pet. App. at A7-9.)

The Federal Circuit then considered the prosecution histories of the patents-in-suit (i.e., the final piece of "intrinsic" evidence). (Pet. App. at A10-11.) It correctly noted that the prosecution history of a patent "limits the interpretation of claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance." (Pet. App. at A10 (quoting *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985).) It further pointed out that it is irrelevant whether a patentee relinquished a potential claim construction by amending the claim or by presenting arguments to distinguish a reference. (Pet. App. at A12); *Spectrum*, 164 F.3d at 1378-79.

In considering the remarks made by the Petitioner to distinguish its claims from the Krug Patent, the Federal Circuit cited at least the following three arguments advanced by the Petitioner: (1) Krug does not disclose a feed tube having a single flow path for both air and water; (2) Krug does not disclose a reservoir; and (3) Krug does not disclose an unpressurized container. (*See* Pet. App. at A11-13.) The Petitioner unsuccessfully argued to the Federal Circuit, and has argued again in its petition, that only the second and third of these arguments were actually necessary to distinguish the Krug patent. (Pet. at 9-10.) After considering the Petitioner's position, however, the Federal Circuit rejected it and held that it is "irrelevant whether Elkay emphasized [the feed tube] argument at the time, or indeed whether Elkay had to relinquish an interpretation of the feed tube limitation that

could cover more than one flow path for liquid and air." (Pet. App. at A12.) The Federal Circuit further noted that "it is the totality of the prosecution history that must be assessed, not the individual segments of the presentation made to the Patent and Trademark Office by the applicant . . . ." *Id.* In accordance with accepted precedent, the Federal Circuit merely decided that the Petitioner cannot now back out of the statements it made during prosecution to recapture subject matter that was clearly disavowed in exchange for its patents. *Id.*; *see also Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 30-34, 40-41 (1997); *Bai v. L & L Wings, Inc.*, 160 F.3d 1350, 1356 (Fed. Cir. 1998); *Spectrum*, 164 F.3d at 1378-79; *CVI/Beta Ventures*, 112 F.3d at 1155; and *Standard Oil Co.*, 774 F.2d at 452.

Based on all of the "intrinsic" evidence, the Federal Circuit interpreted the asserted claims of the patents-in-suit as being limited to a no-spill adapter having a feed tube with a single flow path for both air and water. Because the Respondents' no-spill adapters have a feed tube with separate flow paths for air and water, the Federal Circuit decided that the Respondents were entitled to judgment as a matter of law on the issue of infringement. Accordingly, it reversed and vacated the district court's judgment and award of damages to the Petitioner. The Federal Circuit did not reach several of the Respondents' other grounds for non-infringement, as the feed tube limitation disposed of the case.

Following the Federal Circuit's decision, the Petitioner filed a combined petition for panel rehearing and rehearing *en banc* with the Federal Circuit, alleging the same errors argued in the petition for a writ of certiorari. After considering the combined petition and the Respondents'

answer, the Federal Circuit summarily denied all of the Petitioner's requests.

C. Post-Appeal Proceedings in the District Court

After the Federal Circuit issued its mandate reversing the district court's judgment of infringement, the parties were directed by the district court to attempt to come to an agreement on an order to resolve the issues flowing from the Federal Circuit's decision. After substantial correspondence between the parties regarding which items should be included in the order as well as numerous draft orders, the parties jointly executed and submitted an Agreed Order to the district court for its consideration and issuance. (Resp. App. A at 2a.) The district court issued the Agreed Order without modification.

Among the issues resolved by the Agreed Order was the proper disposition of the Petitioner's infringement complaint in light of the Federal Circuit's decision. The Agreed Order dismissed the Petitioner's complaint with prejudice. (Resp. App. A at 2a.) Conspicuously absent from the petition for a writ of certiorari is any mention of the fact that **the Petitioner voluntarily agreed to dismiss its infringement complaint with prejudice more than two months before filing the petition**. *Id.* Moreover, at no time did the Petitioner ever expressly reserve the right to file a petition for a writ of certiorari to this Court, notwithstanding its agreement to voluntarily dismiss its complaint.

REASONS FOR DENYING THE WRIT

I. The Petition Fails to Allege a Question Worthy of Supreme Court Review

The question raised in the petition for a writ of certiorari is essentially whether, after properly stating the law of claim construction, the Federal Circuit correctly understood the specific facts set forth in the prosecution histories of the patents-in-suit and correctly applied the law of claim construction to the particular patents in this case when it interpreted the claims to exclude a no-spill adapter having a feed tube with separate flow paths for air and water. Respondent's respectfully submit that the error alleged in the petition is not the type of error that is appropriate for Supreme Court review. In particular, Supreme Court Rule 10 provides that "[a] petition for a writ of certiorari will be granted only for compelling reasons," and that "[a] petition for a writ of certiorari is rarely granted when the asserted error consists of erroneous factual findings or the misapplication of a properly stated rule of law" (emphasis added). *See also U.S. v. Johnston*, 268 U.S. 220, 227 (1925) (noting that the Supreme Court does "not grant a certiorari to review evidence and discuss specific facts"); *Texas v. Mead*, 465 U.S. 1043 (1984) (Stevens, J., quoting *U.S. v. Johnston*); *Ross v. Moffitt*, 417 U.S. 600, 616-17 (1974) (Supreme Court review "is discretionary and depends on numerous factors other than the perceived correctness of the judgment we are asked to review").

Although interpretation of the claims of a patent is a question of law, *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 391 (1996), the error alleged by the petition is not that the Federal Circuit applied an incorrect rule of law, but

rather that it misunderstood the particular facts set forth in the prosecution histories of the patents in this case. The petition fails to provide a compelling reason why the Supreme Court should grant a writ of certiorari to review this alleged factually-based error. Indeed, the decision below does not conflict with the decision of any other court, involves no issues of constitutional law, and presents no important questions of federal law. The petition for a writ of certiorari should therefore be denied.

II. The Federal Circuit Correctly Interpreted the Claims to Exclude a No-spill Adapter That Has a Feed Tube Having Separate Flow Paths for Air and Water

Even if the Supreme Court does not deny the petition as not being the type of question appropriate for Supreme Court Review, the Court should deny the petition because the Federal Circuit correctly interpreted the asserted claims of the patents-in-suit to exclude a no-spill adapter that has a feed tube having separate flow paths for air and water. In particular, the Federal Circuit properly found that the Petitioner disavowed an interpretation of the asserted claims that would include a feed tube having separate flow paths for air and water during prosecution of the '531 patent. Based on the proper interpretation of the claims, the Respondents' no-spill adapters cannot infringe the patents-in-suit, and so the Federal Circuit correctly reversed the district court's judgment of infringement.

The Petitioner has accused the Federal Circuit panel of distorting, altering, and intentionally disregarding portions of the prosecution histories of the patents-in-suit. (Pet. at 10-11.) Indeed, the tone of the petition would have the Supreme

Court believe that the Federal Circuit prepared its decision with actual malice toward the Petitioner. Contrary to the allegations in the petition, however, the well-reasoned decision of the Federal Circuit clearly evidences that the panel carefully and objectively considered the "true" prosecution history in its entirety when conducting its *de novo* interpretation of the asserted claims. As explained above, the Federal Circuit simply rejected the district court's incorrect claim construction in favor of the proper interpretation advanced by the Respondents.

A. The Federal Circuit Properly Interpreted the Claims Based On the Intrinsic Evidence of the Patents-in-suit

As set forth above, the Federal Circuit examined the "intrinsic" evidence of the patents-in-suit to ascertain the meaning of the feed tube element recited in each of the asserted claims. (Pet. App. at A6-7); *Markman*, 52 F.3d at 991; *Spectrum*, 164 F.3d at 1378; *CVI/Beta Ventures*, 112 F.3d at 1152. Although it found the claim language and the specifications of the patents not helpful in construing the feed tube element, the Federal Circuit determined that the Petitioner clearly disavowed during prosecution any interpretation of the asserted claims that would include a feed tube having separate flow paths for air and water. (Pet. App. at A11.) Because the Respondents' no-spill adapters do not have a feed tube with a single flow path for both air and water, the Federal Circuit correctly reversed the district court's judgment of infringement.

Moreover, the Federal Circuit properly gave weight to the Examiner's Statement of Reasons for Allowance, which made clear that the Examiner understood and relied

upon the Petitioner's remarks as disavowing a feed tube having separate flow paths for air and water. In particular, the Examiner stated that the claims were allowed, *inter alia*, because the prior art of record does not teach a "feed tube as claimed wherein the feed tube has a passage means which **both** dispenses liquid from the container into the reservoir **and** admits air from the reservoir into the container." (Pet. App. at E30 (emphasis added).) A clearer statement of the perceived scope of the claimed invention cannot be imagined. The Petitioner, however, in its selective account of the prosecution history, fails to deal with the legal effect of the Examiner's remarks.

Furthermore, despite the Examiner's invitation to respond to his Statement of Reasons for Allowance, the Petitioner remained silent. (*See* Pet. App. at E30-31.) If the Petitioner disagreed with the Examiner's interpretation, it was incumbent upon the Petitioner to object to the Examiner's Statement and place the public on notice that it viewed its claims as encompassing a feed tube with multiple passages that permitted separate air and water flow paths. To date, however, the Petitioner has offered no explanation whatsoever for why it failed to address the Examiner's comments if it indeed believed them to be incorrect. In light of the Petitioner's remarks and the Examiner's Statement of Reasons for Allowance, it was entirely proper for the Federal Circuit to conclude that both the Examiner and the Petitioner understood the claims to exclude a feed tube having separate flow paths for air and water.

The Petitioner has argued that the Federal Circuit's decision is erroneous because it "explicitly stated [that] it chose not to rely on the claim language Elkay added by amendment or argued by Elkay in its remarks" to the Patent

and Trademark Office. (Pet. at 10.) It has also alleged that the Federal Circuit's decision improperly "relied on argument 'extrinsic' to the actual record developed by the applicants and the Examiner in the U.S. Patent and Trademark Office." (Pet. at 14). In particular, the Petitioner has argued that by including ellipses and by quoting only selected portions of the Examiner's Statement of Reasons for Allowance, the prosecution history remarks relied on by the Federal Circuit became "extrinsic" evidence. (Pet. at 11-12.)

As an initial matter, the Federal Circuit expressly considered all of the language of the asserted claims and the specifications, as well as the prosecution histories including the claim amendments and the particular remarks relied upon by the Petitioner. (Pet. App. at A7-13.) It found, however, that the claim amendments and the particular remarks relied upon by the Petitioner were not helpful or controlling in determining whether the Petitioner had disavowed an interpretation that included a feed tube having separate flow paths for air and water. (Pet App. at A7-9.) The mere fact that some language was omitted from the Federal Circuit's written decision does not in any way suggest that the Federal Circuit did not consider such language.

Moreover, nowhere in the decision did the Federal Circuit ever rely on or even consider "extrinsic" evidence to interpret the asserted claims of the patents-in-suit. Contrary to the Petitioner's apparent misunderstanding of the law, remarks made during prosecution of the patents-in-suit are intrinsic evidence, not extrinsic evidence. *Markman*, 52 F.3d at 991; *Spectrum*, 164 F.3d at 1378; *CVI/Beta Ventures*, 112 F.3d at 1152. Merely quoting relevant portions of the remarks made by a patentee during prosecution, rather than quoting the entire prosecution history verbatim, does not

somehow magically transform such remarks into extrinsic evidence.

Although the Federal Circuit's decision included ellipses in its decision, it did so merely to help parse the Petitioner's convoluted remarks in an effort to point out how the Petitioner in fact made statements distinguishing Krug based on the Petitioner's single flow path feed tube. (*See* Pet. App. at A9-12.) Similarly, the Federal Circuit quoted only selected portions of the Examiner's Statement of Reasons for Allowance to emphasize that the Examiner clearly understood the Petitioner's remarks as disavowing a feed tube having separate flow paths for air and water. The portions quoted were merely examples of the earlier, contradictory position that the Petitioner had advocated in the Patent and Trademark Office in order to gain allowance of its patent applications. The omitted language in no way alters the meaning of Petitioner's remarks or the legal effect of its concessions that the claimed invention was limited to a device with a single flow path for both air and water.

The Petitioner's reliance on cases such as *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997), and *Graham v. John Deere Co.*, 383 U.S. 1 (1966), for the proposition that the Federal Circuit decision must quote the patent prosecution history word-for-word to prove to the Petitioner that it actually considered each and every remark or claim amendment is misplaced. (Pet. at 13-15.) These cases do not hold that every single word in the prosecution history is necessarily useful or enlightening in interpreting a disputed claim term, and they certainly do not state or imply any particular requirements for proving that the entire prosecution history was actually considered.

Although the Petitioner may prefer otherwise, the Federal Circuit is not required to issue an opinion that quotes word-for-word every fact and issue raised in a party's brief. Nor does it follow, as the Petitioner has alleged, that because the Federal Circuit failed to quote verbatim pages upon pages of the prosecution history, it did not consider the prosecution history in its entirety. The Petitioner's allegation that the Federal Circuit did not consider the "true" prosecution history merely because its decision omitted irrelevant portions is completely meritless. Instead, as noted above, it is the Petitioner who seeks to downplay or ignore statements it made or that were made by the Examiner which are inconsistent with its litigation-induced interpretation of the claims.

B. The Public is Entitled to Rely on the Petitioner's Unequivocal Statements Made to Obtain the Patents-in-suit

Notwithstanding its statements on the public record and its unexplained failure to respond to the Examiner's Statement of Reasons for Allowance, the Petitioner has alleged that the feed tube element should not be limited to having a single flow path for both air and water because Krug does not disclose a reservoir or an unpressurized container. (Pet. at 9-10.) Essentially, the Petitioner has alleged that Krug could have been distinguished on the basis of its lack of reservoir and its pressurized container alone, and so the Petitioner's remarks relating to the feed tube configuration should be disregarded. (Pet. at 11.) Petitioner's allegation, however, is mere speculation and does not comply with the law of claim interpretation.

The Petitioner has never shown and indeed is not even permitted to attempt to show that the Examiner would have allowed the patents-in-suit solely based on the fact that Krug has a pressurized container and lacks a reservoir. *Bai*, 160 F.3d at 1356 (noting that a patentee cannot challenge in an infringement action the necessity of assertions made during prosecution to overcome prior art rejections). The Examiner's Statement of Reasons for Allowance plainly indicates that the Examiner considered each distinction argued by the Petitioner, and that he decided to allow the claims at issue, *inter alia*, based on the Petitioner's assertion that the claimed invention is distinguished from Krug because Krug does not have a feed tube that has a single flow path for both air and water. (*See* Pet. App. at E30.)

Moreover, the patent law clearly provides that the public is entitled to rely on statements made by the Petitioner during prosecution to distinguish prior art references from its claimed invention. *Warner-Jenkinson*, 520 U.S. at 33; *Spectrum*, 164 F.3d at 1378-79; *Digital Biometrics, Inc. v. Identix, Inc.*, 149 F.3d 1335, 1347 (Fed. Cir. 1998); *Bai*, 160 F.3d at 1355-56. By "distinguishing the claimed invention over the prior art, [the Petitioner] is indicating what the claims do not cover." *Spectrum*, 164 F.3d at 1378-79 (emphasis added). Indeed, the public is entitled to rely on the Petitioner's statements, even if such statements were not actually required to obtain the patent. *Bai*, 160 F.3d at 1356.

As much as it may regret the statements it made during prosecution of the patents-in-suit, the Petitioner's remarks clearly placed the public on notice that the claims of its patents were distinguishable from the Krug patent, *inter alia*, on the basis of their single flow path feed tube. The Respondents and other members of the public were entitled

to rely on the Petitioner's declaration that its claims excluded a feed tube having separate flow paths for air and water. The Petitioner cannot now pick and choose which limitations in retrospect it should not have argued to the Examiner, so that it can recapture disclaimed subject matter that is necessary to enforce it patents. *Spectrum*, 164 F.3d at 1379.

For the reasons explained above, the Federal Circuit correctly interpreted the claims of the patents-in-suit to exclude a no-spill adapter with a feed tube having separate flow paths for air and water. Because the Respondent's no-spill adapters do not include a feed tube having a single flow path for both air and water, the Federal Circuit correctly reversed the district court's judgment of infringement. The petition for a writ of certiorari should therefore be denied.

III. There Is No Longer a Case or Controversy Between the Parties

As explained above, on December 29, 1999, more than two months before filing the petition for a writ of certiorari, the Petitioner consented to the dismissal of its complaint with prejudice, and the district court issued an Agreed Order signed by both parties effectuating the dismissal. (Opp. App. A at 1.) The Petitioner's consenting to the issuance of the Agreed Order extinguished the "case or controversy" between the parties related to the issue raised in the petition, as well as the jurisdiction of the Supreme Court to accept the petition. *Druhan v. American Mutual Life*, 166 F.3d 1324, 1326 (11th Cir. 1999) (holding that there was no longer a "case or controversy" and therefore no jurisdiction to decide the appeal after the plaintiff voluntarily dismissed its complaint with prejudice); *Woodward v. STP Corp.*, 170 F.3d 1043, 1044 (11th Cir. 1999) (holding that the final

judgment resulting from the plaintiff's voluntary dismissal of its complaint with prejudice was not appealable "because it was obtained at the request of the plaintiff and there is therefore no 'case or controversy' in regard to it."); *Association of Commmunity Org. For Reform Now v. Edgar*, 99 F.3d 261, 262 (7th Cir. 1996) ("A party to a consent decree or other judgment entered by consent may not appeal unless it explicitly reserves the right to appeal.").

By agreeing to the dismissal of its complaint with prejudice without reserving the right to file a petition for a writ of certiorari, the Petitioner accepted the decision of the Federal Circuit, gave up its right to petition the Supreme Court for a writ of certiorari, and ended its case. *Druhan*, 166 F.3d at 1326; *Woodward*, 170 F.3d at 1044; *Edgar*, 99 F.3d at 262. Accordingly, in light of the "case or controversy" requirement of Article III of the United States Constitution, the Supreme Court should deny the petition. U.S. Const. art. III, § 2; *Deakins v. Monaghan*, 484 U.S. 193, 199 (1988) ("Article III of the Constitution limits federal courts to the adjudication of actual, ongoing controversies between litigants."); *Preiser v. Newkirk*, 422 U.S. 395, 401 (1975) ("The exercise of judicial power under Art. III of the Constitution depends on the existence of a case or controversy.").

CONCLUSION

The purpose of a writ of certiorari is not to correct alleged misapplications of properly stated rules of law by the courts of appeals. Indeed, the Petitioner has already brought to the Federal Circuit's attention in a combined petition for panel rehearing and rehearing *en banc* the same errors alleged in the petition for a writ of certiorari. Instead of

presenting issues worthy of Supreme Court review, the Petitioner essentially seeks the same rehearing in this Court to correct what it perceives as the Federal Circuit's misunderstanding of the prosecution histories of the patents-in-suit. For the foregoing reasons, the petition should be denied.

Respectfully submitted. March 6, 2000

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APPENDIX

RESPONDENTS'
APPENDIX A

UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

Civil Action No. 93-CV-5106 WRA

ELKAY MANUFACTURING COMPANY
Plaintiff,

v.

EBCO MANUFACTURING COMPANY
and EBTECH CORPORATION,
Defendants.

AGREED ORDER VACATING THE INJUNCTION
AND THE JUDGMENT AS TO INFRINGEMENT
AND DAMAGES

In light of the November 12, 1999 mandate of the Federal Circuit reversing the finding of infringement and vacating the award of damages in the above-referenced case,

IT IS HEREBY ORDERED THAT:

1. The Judgment of infringement of Elkay's U.S. Patent Nos. 5,222,531 (the '531 patent) and 5,289,855 (the '855 patent) by Ebco and Ebtech in the manufacture, use, sale, and offering for sale of WaterGuard I, II, and III no-spill adapters is vacated.

2. Elkay's Complaint asserting infringement of the '531 and '855 patents is dismissed with prejudice.
3. Ebco and Ebtech have failed to prove by clear and convincing evidence that the asserted claims of U.S. Patent Nos. 5,222,531 and 5,289,855 are invalid and unenforceable.
4. The counterclaims of Ebco and Ebtech seeking a declaratory judgment that the '531 and '855 patents are invalid and unenforceable are dismissed as moot.
5. The Court's awards of damages in the July 10, 1998 Judgment and the February 5, 1999 Supplemental Judgment are vacated.
6. The Court's award of Federal Rule of Civil Procedure 54(d) costs to Elkay in the February 5, 1999 Supplemental Judgment is vacated.
7. The permanent injunction entered in the Court's July 10, 1998 Order, as amended July 30, 1998, enjoining Ebco and Ebtech from manufacturing, using, selling, and offering for sale WaterGuard I, II, and III no-spill adapters is vacated.

Agreed to by:

/s/ Charles H. Mottier
Attorney for Elkay

/s/ Mark W. Hetzler
Attorney for Ebco and Ebtech

/s/ Wayne R. Andersen
United States District Judge

Dated: December 29, 1999